

Serial No.: 09/663,963
Art Unit: 1651

REMARKS/ARGUMENTS

Favorable consideration and allowance of the instant application is respectfully requested in view of the following remarks.

Applicant hereby renews its traversal of the Examiner's restriction requirement and respectfully requests reconsideration and withdrawal thereof.

The Examiner's rejections, as they pertain to the patentability of the claims, are respectfully traversed.

Claims 1-3, 6-7 and 10-12 remain rejected under 35 U.S.C. § 102(b) as being anticipated by Shirai et al. (US 5,618,708). This rejection is again respectfully traversed for the following reasons.

Applicant had previously argued that the Shirai reference failed to anticipate the claimed invention on the grounds that it failed to disclose each and every element thereof. More particularly, the claimed invention is directed to a fermentation medium containing, among other elements, a source of biotin **substantially free of both particulate matter and bacteria**.

In response thereto, the Examiner contends that, "...it is common knowledge in the microbiological art that a culture medium is sterilized prior to inoculating it with a particular organism." See, *Paper No. 14*, page 2. On the basis of this premise, the Examiner has maintained his anticipation rejection of the present invention. Applicant respectfully submits that both the above-noted premise, and resultant conclusion of anticipation, are defective for the following reasons.

First, the Examiner has failed to provide any evidence/proof in support of the above statement. It has been held that, "The Patent Office ... may not, because it may **doubt** that the invention is patentable, resort to speculation, unfounded assumptions or hindsight to supply deficiencies in its factual basis." See, *In re Warner*, 154 USPQ 173, 178 (CCPA

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1967). Unless the Examiner can offer some proof in support of the blanket contention regarding it being commonly known that **PRESUMABLY ALL** culture mediums are automatically sterilized prior to inoculation, this premise amounts to nothing more than the Examiner's opinion, which carries no weight whatsoever in a determination of anticipation.

Secondly, the Examiner must also establish that in the event the culture medium is in fact sterilized, that the biotin present therein is consequently rendered substantially free of bacteria. In the absence of any proof in support of this contention, this, too, amounts to nothing more than the Examiner's opinion.

Finally, the Examiner must also show that in the event the culture medium is in fact sterilized, that the biotin present therein is consequently rendered substantially free of particulate matter. It is unclear to Applicant how a sterilization step would result in the elimination of particulate matter in the biotin. Nevertheless, in the absence of any proof in support of this contention, this too amounts to nothing more than the Examiner's opinion.

Furthermore, Applicant had also previously argued that the presently claimed fermentation medium **requires** the presence of biotin, a source of phosphate and at least one metal component, in said fermentation medium. The Shirai reference, on the other hand, discloses the use of **all** of these components as being **merely optional**. As a result, since this reference fails to **require** the presence of biotin, a source of phosphate and at least one metal component, in its fermentation medium, it cannot serve to anticipate the claimed invention, on the grounds that each and every element of the claimed invention is not disclosed by the prior art reference.

In response thereto, the Examiner counters with the argument that Shirai discloses a chelating agent and antifoam as components of their culture composition, citing col. 6, lines 1 and 31, and then goes on to state, "...even though their statement might seem that these components are optional in their culture medium." See, *Paper No. 14*, page 3.

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Neither the Examiner's statement, nor the logic behind it, make any sense to Applicant. Thus, clarification, is respectfully requested. Nevertheless, Applicant would like to note that it is well settled that an anticipatory reference must clearly and unequivocally disclose the claimed invention or direct those skilled in the art to the claimed invention without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the reference. See, *In re Arkley*, 172 USPQ 524, 526 (CCPA 1972). It is clear that based on this reference's disclosure, a significant amount of picking and choosing would need to go on prior to one of ordinary skill in the art arriving at the claimed invention. Consequently, for this reason as well, the Shirai reference is believed by Applicant to fail to anticipate the claimed invention.

Accordingly, for all of the above-stated reasons, reconsideration and withdrawal of this rejection is respectfully requested.

It is believed that the foregoing reply is completely responsive under 37 CFR 1.111 and that all grounds for rejection are completely avoided and/or overcome. A Notice of Allowance is therefore earnestly requested.

The Examiner is requested to telephone the undersigned attorney if any further questions remain which can be resolved by a telephone interview.

Respectfully submitted,



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